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EXAMINER

MUSSER, BARBARA J

ART UNIT PAPER NUMBER

1733

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,331

Applicant(s)

HONIG, ERHARD

Examiner

Barbara J. Musser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 7-23 is/are pending in the application.
- 4a) Of the above claim(s) 12-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of group I in the paper dated 10/07/03 is acknowledged. The traversal is on the ground(s) that the apparatus of claim one squeezing the extruded material between the forming means and the edge of the workpiece, therefore requiring the workpiece to have an edge. This is not found persuasive because the claim does not require the workpiece. All that is required is that the device be capable of performing the same function. The forming means can form the desired shape on a surface other than the edge as there are no limitations to the apparatus that would prevent it from applying and forming the strip somewhere other than an edge.

Applicant argues the product claims require the product to be made in accordance with the method and apparatus claims. This is not found persuasive because in U.S. practice, the product by process claims are merely product claims which could be made by a materially different process or apparatus such as cutting the strip to shape and applying it to a workpiece. With product by process claims, applicant has the burden to show that the unique product of the product by process claims can only be made using the specified process or apparatus.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 10 recites the limitation "the cooling means" in line 1 and "the decorative layer" in lines 2-3. There is insufficient antecedent basis for these limitations in the claim. It is unclear what claim this is intended to depend from as claim 6, from which it depends, has been canceled.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Munro(U.S Patent 4,597,821).

Munro discloses an apparatus for applying a strip to the edge of a workpiece using a device which extrudes adhesive onto the edge of the workpiece. A strip of material is applied thereto and a roller(66, 98) conforms the strip and adhesive to the shape of the workpiece.(Col. 1, ll. 6-14; Col. 2, ll. 58-67; Col. 7, ll. 28-33) The rollers have a circumferential profile corresponding to the desired flat profile, and they squeeze the extruded material against the edge of the workpiece. While the claimed profile is

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not required to have a shape other than flat, it is noted that the edge of the workpiece can be curved, (Col. 7, ll. 38-41 and since the purpose of the edge bander is to form the material such that there is a regulated thickness between the band and the workpiece edge, one in the art would understand that the roller would also be curved, having the desired profile.

7. Claims 1, 2, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakata et al. (U.S. Patent 5,693,174).

Nakata et al. discloses an apparatus for applying strip of material to the edge of a workpiece. The material deformed into a desired shape using a pressing means. (Figure 7; Col. 6, ll. 25-29, 45-53) The apparatus is capable of applying the strip to the edge of a plate-like workpiece recited in claim 1.

Regarding claim 2, a robotic arm moves the workpiece past the extruder. (Figure 7)

Regarding claim 7, primer can be applied to the window edge prior to application of the strip of material. (Col. 6, ll. 48-50)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 1-4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munro as applied to claim 1 above, and further in view of Nakata et al.

The reference cited above does not disclose moving the workpiece relative to the edge bander. Nakata et al. discloses it is known to move a workpiece past an extruder which extrudes material on the edge. It would have been obvious to one of ordinary skill in the art at the time the invention was made to move the workpiece past the extruder as this is an obvious alternative to moving the extruder as shown for example by Nakata et al. which discloses extruding a strip onto the edge of a workpiece where the workpiece moves past the extruder.(Figure 7)

Regarding claim 3, Munro does not specifically disclose support means for the workpiece which clamp the workpiece to the support means. However, the reference does disclose that the device is intended to be movable about the workpiece and that the workpiece is placed on a table.(Abstract, Col. 7, ll. 67- Col. 8, ll. 3) It would have been obvious to one of ordinary skill in the art at the time the invention was made to clamp the workpiece to the table to prevent it moving while applying the edge strip.

Regarding claim 4, while the reference discloses pressing the forming means against the workpiece, one in the art would readily appreciate that an obvious alternative would be to press the workpiece against the forming means. Only the expected results would be achieved.

10. Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munro as applied to claims 1 and 9 above, and further in view of Hasenkamp et

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al.(WO98/04390). U.S. Patent 6,432,237 is considered an English language translation thereof, and all column and line numbers refer to it.

The reference cited above does not disclose cooling the strip after application of the decorative material. Hasenkamp et al. discloses it is known when applying thermoplastic to the edge of a workpiece to cool the material so that it does not penetrate too far into the edge of the workpiece.(Col. 3, ll. 16-23) It would have been obvious to one of ordinary skill in the art at the time the invention was made to cool the strip of material applied to the workpiece since this would prevent the material from penetrating too far into the workpiece.(Col. 3, ll. 16-23)

Regarding claim 10, while the reference is silent as to when the cooling takes place, one in the art would appreciate that the cooling would occur after application of the decorative material as otherwise the surface of the adhesive would have cooled too much to allow bonding of the decorative material to the extruded strip.

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Munro and Nakata et al. as applied to claim 2 above, and further in view of Ecklund et al.

The reference cited above do not disclose using a pair of driven roll to move the workpiece relative to the edge bander. Ecklund et al. discloses it is known to move a workpiece past an extruder which extrudes material on the edge by using a pair of driven rolls. It would have been obvious to one of ordinary skill in the art at the time the invention was made to move the workpiece past the extruder since the device of Nakata et al. would not work well with a material like wood which is not easier held by suction

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cups and since Ecklund et al. discloses it is known to use driven rollers to move workpieces past an extruder.(Figure 1)

Response to Arguments

12. Applicant's arguments filed 10/7/03 have been fully considered but they are not persuasive.

Regarding applicant's argument that Munro and Nakata do not teach rollers that shape the adhesive to a curved surface, applicant does not require a curved surface for the rollers. Rather the rollers form the extruded material into a desired profile. The claim does not exclude the desired profile being flat. Additionally, while Munro does not explicitly state the rollers are curved, it does indicate a uniform adhesive thickness is formed and that the edge of the workpiece can be curved. Since a uniform thickness adhesive layer is formed on a curved workpiece, the roller which presses the adhesive against the surface must be curved.

Regarding applicant's argument that the claim requires extruding a plastic and that Munro is an adhesive, the claim does not require a source of plastic and therefore the apparatus need only be capable of extruding a plastic. Additionally, hot melt adhesives are conventionally thermoplastic materials and thus are plastic.

Upon further consideration, the subject matter previously indicated allowable in the interview summary is no longer deemed allowable.

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Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McXinnon(U.S. Patent 4,849,063) is cited as another example of an edge bander which applies a hot malt adhesive to the edge of a workpiece and then applies a decorative strip.(Figure 2)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Barbara J. Musser** whose telephone number is (571) 272-1222. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571)-272-1226. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

BJM
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